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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,558	09/27/2001	Gary Brian Merrill	01P17802US	3870

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Siemens Corporation  
Intellectual Property Department  
186 Wood Avenue South  
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EXAMINER

FIORILLA, CHRISTOPHER A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 12/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/965,558	<b>Applicant(s)</b> MERRILL ET AL.	
	<b>Examiner</b> Christopher A. Fiorilla	<b>Art Unit</b> 1731	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____                                    |

1. The disclosure is objected to because of the following informalities:

On page 5, line 18, the first occurrence of the word "a" should be changed to \*\* an \*\*.

On page 6, line 29 "fillvoid" should be changed to \*\* fill void \*\*.

On page 13, line 22, the word "insulting" should be changed to \*\* insulating \*\*.

Appropriate correction is required.

2. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 13, the word "poring" is misspelled.

In claim 1, line 16, the phrase "forcing the slurry" is indefinite in that the claim previously refers to a "slurry or a binder medium". Thus, it is not clear as to whether the slurry option is required. Thus, the metes and bounds of the claim cannot be readily determined.

In the dependent claims, the phrase "method of according to claim" appears to be grammatically incorrect. The word "of" could be deleted from these phrases to make them grammatically correct.

In claim 3, line 2, the phrase "the first permeable restraining structure" has no antecedent basis.

Claim 3 is indefinite in that it recites "the extracting member and the second permeable member defines the first void" which contradicts the phrase in claim 1 which recites "defining a first void between the first and second permeable structures". Thus, the metes and bounds of the claims cannot be readily determined.

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In claim 6, the phrase "the chamber" has no antecedent basis.

In claim 6, the phrase "drying in the insulating material" is grammatically incorrect.

In claim 8, the phrase "the ceramic material" has no antecedent basis.

In claim 11, the phrase "the ceramic material" has no antecedent basis.

Claim 12 is indefinite in that the preamble recites "formed into geometric shapes" but the body of the claim does not refer to "geometric shapes" in general but rather specifically recites spheres.

In claim 13, the phrase "the extraction membrane" has no antecedent basis.

In claim 13, the phrase "the liquid" has no antecedent basis.

In claim 15, line 2, it appears as though the word "and" should be changed to \*\* an \*\*.

In claim 19, the phrase "the chamber" has no antecedent basis.

In claim 19, the phrase "drying in the ceramic material" has no antecedent basis.

A claim is indefinite when it specifies "predetermined" temperatures etc. when "predetermined" according to applicants' definition merely means determined beforehand. See *Joseph E. Seagram & Sons, Inc. V. Marzall, Comr. Pats.*, 84 USPQ 180 (CA DC 1950). Claim 20 is indefinite for this reason.

In claim 24, the phrase "the permeable restraining structure" has no antecedent basis.

3. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a process which utilizes a sinterable binder (e.g. page 10, line 22) and fires the shaped material (e.g. p.4, line 7), does not reasonably provide enablement for the process as generically claimed. The specification does not enable any person skilled in the art to

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which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

4. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a process which utilizes a fibrous material (12) to define a side of the void, or sphere cavity (e.g. page 12, line 14), does not reasonably provide enablement for the process as generically claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

5. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a process which removes the insulating material from the mold in which it is formed (e.g. page 13, line 23), does not reasonably provide enablement for the process as generically claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Fiorilla whose telephone number is 703-308-0674. The examiner can normally be reached on M-F, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

A handwritten signature in black ink, appearing to read 'CA Fiorilla', with a stylized flourish at the end.

**Christopher A. Fiorilla**  
**Primary Examiner**  
**Art Unit 1731**